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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/066,796

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Koichi Kamon

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20277

7590

10/19/2006

MCDERMOTT WILL & EMERY LLP  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER

SHAH, AMEE A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/066,796	KAMON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Amea A. Shah	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,11,13,15-19 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,11,13,15-19 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

Claims 1-8, 10, 11, 13, 15-19 and 22-27 are pending in this action.

#### ***Response to Amendment***

The Amendment filed July 25, 2006, has been entered. Claims 1, 7, 8, 10, 13 and 22 have been amended, claims 20 and 21 have been cancelled, and claims 23-27 have been added. Therefore, claims 1-8, 10, 11, 13, 15-19 and 22-27 are pending in this action.

#### ***Response to Arguments***

Applicant's arguments filed July 25, 2006, regarding the 35 U.S.C. §112, first paragraph, rejections are persuasive and the §112 rejections are withdrawn.

Applicant's arguments with respect to claims 1-8, 10, 11, 13 and 15-19 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendments.

#### ***Claim Objections***

Claim 24 is objected to because of the following informalities: it contains grammatical/idiomatic errors, i.e. "is changed smaller.." in line 2 should likely be --is changed to be smaller-- and "is changed larger..." in lines 3-4 should likely be --is changed to be larger--. Appropriate correction is required.

***Examiner Note***

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 25-27 are rejected under 35 U.S.C. §102(e) as being anticipated by Feld et al., US 2001/0026272 A1 (hereafter referred to as “Feld”).**

Referring to claim 25. Feld discloses an electronic catalogue system for displaying on one screen an image of a commercial product and an image of an article for comparison in order for a viewer of the one screen to acquire a visual recognition of the size of the commercial product as compared to the size of the article for comparison, comprising:

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- reader for reading three-dimensional data of the commercial product and three-dimensional data of the article for comparison (§§0035 and 0039-0040 – note the reader is the software, the commercial product is the clothing and the article for comparison is the model);
- observation image generator for generating an observation image in which the image of the commercial product and the image of the article for comparison are located at predetermined positions based on the read three-dimensional data of the commercial product and three-dimensional data of the article for comparison (§§0040 and 0049 – note the image generator is the software); and
- displaying device for displaying the generated observation image, and displaying device including said one screen, wherein the image of the commercial product and the image of the article for comparison are displayed under a same scale on said one screen of the displaying device, and the electronic catalogue system provides the article for comparison which size is predetermined in the electronic catalogue system (Fig. 4 and §§0035-0037, 0040 and 0049 – note the predetermined size of the article for comparison is the predetermined sizes of the generic models).

Referring to claim 26. Feld discloses the electronic catalogue system according to claim 25 wherein the article for comparison is selected after the commercial product is selected by a terminal apparatus (§0049 – note that the software is capable of performing its functions, including selecting a model, before or after the user selected a commercial product).

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Referring to claim 27. Feld discloses the electronic catalogue system according to claim 25 wherein the article for comparison is replaced from the first chosen article for comparison for the specified commercial product (¶¶0048-0049 – note that a number of models may be used, and that the software functions can be repeated for each model).

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

**Claims 1-8, 10, 11, 13, 15-19 and 22-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Feld in view of Bornstein, US 6,144,388 (hereafter referred to as “Bornstein”).**

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Referring to claim 1. Feld discloses an electronic catalogue system for displaying on one screen an image of a commercial product and an image of an article for comparison in order for a viewer of the one screen to acquire a visual recognition of the size of the commercial product as compared to the size of the article for comparison, comprising:

- reader for reading three-dimensional data of the commercial product and three-dimensional data of the article for comparison (¶¶0035 and 0039-0040 – note the reader is the software, the commercial product is the clothing and the article for comparison is the model);
- observation image generator for generating an observation image in which the image of the commercial product and the image of the article for comparison are located at predetermined positions based on the read three-dimensional data of the commercial product and three-dimensional data of the article for comparison (¶¶0040 and 0049 – note the image generator is the software); and
- displaying device for displaying the generated observation images, said displaying device including said one screen wherein the image of the commercial product and the image of the article for comparison are displayed under a same scale on said one screen of the displaying device (Fig. 4 and ¶¶0036-0037, 0040 and 0049).

Feld discloses positioning the image of the commercial product onto the article of comparison (¶0058), but does not specifically disclose wherein a positional relationship between the image of the commercial product and the image of the article for comparison on the screen can be changed by a request of a terminal apparatus. In the same field of endeavor, Bornstein discloses a system and process for displaying articles of clothing on a person including displaying an image of a commercial product (i.e. clothing or eyeglasses) with an article for

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comparison (i.e. an image of a person and/or his face) under a same scale wherein a positional relationship between the image of the commercial product and the image of the article for comparison on the screen can be changed by a request of a terminal apparatus (col. 20, lines 11-16 and 31-47 and col. 25, line 63 through col. 26, line 25 – note that the position of the clothing and/or eyeglasses are manually manipulated onto the person).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Feld to include the teachings of Bornstein to allow for the changing of a positional relationship between the images of the commercial product and the article for comparison. Doing so would allow for a user to achieve a more realistic and natural depiction of the user wearing a article by manipulating the position of the article to the most natural/realistic position, as suggested by Bornstein (col. 29, lines 42-49).

Referring to claim 2. Feld in view of Bornstein also discloses the electronic catalogue system according to claim 1 further comprising: designator for designating a rotation axis and an angle of rotation (Feld, ¶0038 – note the designator is the mouse); and rotating device for rotating the observation image based on the designated rotation axis and the designated angle of rotation (Feld, ¶0038 – note the rotating device is the mouse working with the software)

Referring to claim 3. Feld in view of Bornstein also discloses the electronic catalogue system according to claim 1 further comprising: designator for designating a rotation axis and an angle of rotation for each one of the commercial product and the article for comparison (Feld, ¶0038); and rotating device for rotating the image of the commercial product or the image of the



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article for comparison based on the designated rotation axis and the designated angle of rotation (Feld, ¶0038).

Referring to claim 4. Feld in view of Bornstein also discloses the electronic catalogue system according to claim 1 further comprising: dispose device for automatically selecting the article for comparison in accordance with a type and a size of the commercial product (Feld, ¶¶0056, 0061 and 0065-0067).

Referring to claim 5. Feld in view of Bornstein also discloses the electronic catalogue system according to claim 1 further comprising: article for comparison storing device for storing three-dimensional data of a plurality of articles for comparison (Feld, ¶0047 – note the storing device is the model bank); and selector for selecting the three-dimensional data of one article for comparison from the article for comparison storing device, wherein the reader reads the three-dimensional data of the selected article for comparison (Feld, ¶0047 – note the selector is the mouse with the software).

Referring to claim 6. Feld in view of Bornstein also discloses the electronic catalogue system according to claim 1 further comprising: product storing device for storing a product information regarding features of the commercial product (Feld, Fig. 3 and ¶0039), said product information being associated with the three-dimensional data of the commercial product, wherein the displaying device displays the observation image together with the product information which corresponds to the image of the commercial product which is included in the observation

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image (Feld, ¶0058 – note the product information is information relating to virtual wear articles).

Referring to claims 7, 8, 10, 11 and 13. All of the limitations in apparatus claims 7, 8 and 10 are closely parallel to the limitations of system claims 1 and 4 analyzed above and are rejected on the same bases.

Referring to claims 15-19. Feld in view of Bornstein also discloses the electronic catalogue system, server and program products according to claims 1, 7, 8, 10 and 13, wherein a display magnification for the article for comparison is calculated based on the size of the article for comparison, and both the size and a display magnification of the displayed commercial product (Feld, ¶¶0038 and 0065-0067), and the article for comparison is displayed at a predetermined position within the observation image based on the calculated display magnification (Feld, ¶¶0065-0067).

Referring to claim 22. Feld discloses an electronic catalogue system for displaying on one screen a image of a commercial product and an image of an article for comparison in order for a viewer of the one screen to acquire a visual recognition of the size of the commercial product as compared to the size of the article for comparison, comprising:

- reader for reading three-dimensional data of the commercial product and three-dimensional data of the article for comparison (page 3, ¶0035 and page 4, ¶¶0039-0040 – note

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the reader is the software, the commercial product is the clothing and the article for comparison is the model);

- observation image generator for generating an observation image in which the image of the commercial product and the image of the article for comparison are located at predetermined positions based on the read three-dimensional data of the commercial product and three-dimensional data of the article for comparison (page 4, ¶0040 and page 5, ¶0049 – note the image generator is the software); and
- displaying device for displaying the generated observation image, said displaying device including said one screen, wherein the image of the commercial product and the image of the article for comparison are displayed under a same scale on said one screen of the displaying device, the image of the commercial product and the image of the article for comparison do not overlap with each other in an observation window, and the observation image does not deviate from the observation window (Fig. 4 and page 3, ¶¶0036-0038, page 4, ¶0040 and page 5, ¶0049).

Feld discloses positioning the image of the commercial product onto the article of comparison (¶0058), but does not specifically disclose wherein a positional relationship between the image of the commercial product and the image of the article for comparison on the screen can be changed by a request of a terminal apparatus. In the same field of endeavor, Bornstein discloses a system and process for displaying articles of clothing on a person including displaying an image of a commercial product (i.e. clothing or eyeglasses) with an article for comparison (i.e. an image of a person and/or his face) under a same scale wherein a positional relationship between the image of the commercial product and the image of the article for

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comparison on the screen can be changed by a request of a terminal apparatus (col. 20, lines 11-16 and 31-47 and col. 25, line 63 through col. 26, line 25 – note that the position of the clothing and/or eyeglasses are manually manipulated onto the person).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Feld to include the teachings of Bornstein to allow for the changing of a positional relationship between the images of the commercial product and the article for comparison. Doing so would allow for a user to achieve a more realistic and natural depiction of the user wearing a article by manipulating the position of the article to the most natural/realistic position, as suggested by Bornstein (col. 29, lines 42-49).

Referring to claims 23 and 24. Feld in view of Bornstein discloses the catalogue system according to claim 1 but does not specifically disclose wherein when a positional relationship between the image of the commercial product and the image of the article for comparison on the screen is changed, the size of the image of the article for comparison is changed to a size which corresponds to the position of the article for comparison, i.e. smaller when the image of the article for comparison is moved backward, and larger when the image of the article for comparison is moved forward. However, the displaying device of Feld in view of Bornstein is capable of changing the size of the image of the article for comparison to correspond to the position of the article performing (Feld, ¶¶0038, 0051-0052 – note that the article for comparison can be manipulated in many fashions and the viewpoint can be enlarged or reduced).

Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *see In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA

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1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (Bd. Pat. App. & Inter. 1987). Thus the structural limitations of claims 23 and 24, including an displaying device allowing for the size of the article of comparison to be changed based on position, are disclosed in Feld in view of Bornstein as described herein. As described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (1) Berger et al., US 6,414,693 B1, discloses a system and method for customizing articles on a computer-based display including manipulating the positional relationship between the article of comparison and a commercial product (*see, e.g.*, cols. 7-8); and (2) Motomiya et al., US 6,083,267, discloses a system and method for designing an accessory including manipulating the positional relationship between the article of comparison and a commercial product (*see, e.g.*, cols. 5-6).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

October 16, 2006

  
YOGESH C. GARG  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600